REMARKS/ARGUMENTS

STATUS OF CLAIMS

In response to the Office Action dated November 6, 2006, claims 1, 9 and 11 have been amended, claims 5-8 and 10 have been canceled. Claims 1-4, 9 and 11 are now pending in this application. No new matter has been added.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1-11 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In support of this position, the Examiner identifies a number of phrases that are unclear.

By this response, independent claims 1, 9 and 11 have been amended to address the noted points of indefiniteness. Specifically, unclear and/or vague language has been deleted in favor of language believed to recite the invention with the degree of precision and particularity required by the statute.

It should be noted also that case law precedent has established that an analysis under 35 U.S.C. § 112 begins with a determination of whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. Claim language is viewed not in a vacuum, but in light of the teachings of the prior art and of the application disclosure as it would be interpreted by one possessing the ordinary level of skill in the art. ***In re Johnson***, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977); ***In re Moore***, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971).

A decision on whether a claim is invalid under this section of the statute requires a determination of whether those skilled in the art would understand what is claimed when the claim is read in light of the specification, ***Seattle Box Co. v Industrial Crating & Packing***, 731 F.2d 381, 385, 221 U.S.P.Q. 568, 574 (Fed. Cir. 1984).

In determining definiteness, no claim may be read apart from and independent from the disclosure on which it is based. ***In re Cohn***, 169 U.S.P.Q. 95, 98 (CCPA 1971); ***In re Kroekel***, 183 U.S.P.Q. 610, 612 (CCPA 1974):

> ... claims are not to be considered in a vacuum, "but always in light of the teachings of the prior art and the particular application disclosure as it would be viewed by one possessing the ordinary level of skill in the pertinent art." When considered in light of the prior art and the specification, claims otherwise indefinite may be found reasonably definite.

The Examiner's questions and problems concerning clarity result from the fact that the Examiner is reading the claims in a vacuum and not ***in light of the specification***.

With regard to the term "soft magnetic material powder" recited in claims 1, 9 and 11, page 3, lines 16-24 of the specification describe:

> The soft magnetic material powder is a material whose magnetization is more likely to be oriented in the direction of a magnetic field applied externally, namely, an easily-magnetized material. Examples of the soft magnetic material powder include an iron-nickel alloy (Permalloy (R)), an iron-cobalt alloy (permendur), an iron-chrome alloy (magnetic stainless steel), an iron-silicon alloy, an iron-aluminum-silicon alloy (sendust), a cobalt-tungsten-chrome-carbon alloy (Stellite (R)), a nickel-chrome-boron-iron-silicon alloy (Colmonoy (R)), iron-nickel-cobalt alloy (perminvar) powder, iron-aluminum alloy (alperm) powder, and others.

With regard to concave portion provided around said bore, recited in claim 2, page 12, lines 8-12 of the specification describe:

> As shown in Figs. 4 and 5, the present example has a concave portion 4a provided around an opening of bore 2 at bottom face 3 of composite body 1 for absorbing an electromagnetic wave. Namely, a concave portion extending from the bottom face to the top face of the unit cell is provided. Other structures are basically the same with the case shown in Figs. 1-3.

As to "scale-like shape " recited in claim 7, this means a structure that has a flattened shape similar to the scale of a fish. Page 5, lines 15-21 of the specification describe:

> Preferably, the soft magnetic material powder has a scale-like shape, and has a ratio of the maximum length and a thickness of approximately 3-20. This is because if the aspect ratio of each of the particles (the ratio of the maximum length and the thickness) is approximately less than 3, permeability is lowered, which results in lower electromagnetic wave absorbing performance. If the aspect ratio exceeds approximately 20, it becomes difficult to manufacture the soft magnetic material powder.

As to convex portions are provided at top faces of intersections of the wall portions, and concave portions are provided at top faces of the wall portions located between the intersections, recited in claim 9, page 14, line 11 through page 15, line 13 describes:

> In each of the embodiments above, the top face of wall portion 4 located around bore 2 of composite body 1 for absorbing an electromagnetic wave is formed of a flat plane. However, it is preferable to reduce a flat area at the top face of wall portion 4 of composite body 1 for absorbing an electromagnetic wave. For example, concave and convex portions or an inclined plane may be provided at the top face of wall portion 4 to reduce the flat area at the top face. By doing so, electromagnetic wave absorbing performance can be improved.
>
> More specifically, as shown in Fig. 14, an inclined plane 11 may be provided at the top face of wall portion 4 to allow the top face of wall portion 4 to have a mountain-like shape. As shown in Fig. 15, the top face of wall portion 4 may take a mountain-like shape defined by a convex portion 12 having a peak at a crossing point of wall portions 4 and a concave portion 13 having a bottom at a midpoint of the crossing points,

and may be provided with inclined plane 11 as in the case of Fig. 14. As shown in Fig. 16, the top face of wall portion 4 may take a mountain-like shape defined by concave portion13 having a bottom at the crossing point of wall portions 4 and convex portion 12 having a peak at the midpoint of the crossing points, and may be provided with inclined plane 11 as in the case of Fig. 14.

The shape shown in Fig. 15 is described in detail. While convex portion 12 is provided at a top face of an intersection of wall portions 4, concave portion 13 is provided at the top face of wall portion 4 located between the intersections. Accordingly, concave portion 13 and convex portion 12 form a V-shaped portion at the top face of wall portion 4, and a longitudinally central portion at the top face of wall portion 4 is the most concave. More specifically, a pair of inclined planes 11 arranged in a direction of the thickness of wall portion 4 (direction orthogonal to a longitudinal direction of the top face of wall portion 4) are combined to form the top face of wall portion 4 such that a central portion in a direction of the thickness of wall portion 4 protrudes most upwardly at the top face of wall portion 4, to form a V-shaped ridge extending in the longitudinal direction of the top face of wall portion 4 at a junction of the pair of inclined planes 11 (at the peak of a mountain-like shape). At the intersection of wall portions 4, four ridges at the top faces of wall portions 4 intersect, and the crossing point of the four ridges corresponds to the peak of convex portion 12.

As to the verb " kneading", recited in claim 11, a definition of "knead" obtained via the Internet by typing in "define knead" to Google, is:

> To make a dough or dough-like substance smooth and elastic by folding, stretching, and pressing it continuously until it reaches the desired texture.

Also, MPEP § 2173.05 (a) II. states:

> Consistent with the well-established axiom in patent law that a patentee or applicant is free to be his or her own lexicographer, a patentee or applicant may use terms in a manner contrary to or inconsistent with one or more of their ordinary meanings if the written description clearly redefines the terms. See, e.g., *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999) ("While we have held many times that a patentee can act as his own lexicographer to specifically define terms of a claim contrary to their ordinary meaning," in such a situation the written description must clearly redefine a claim term "so as to put a reasonable competitor or one

> reasonably skilled in the art on notice that the patentee intended to so redefine that claim term."); *Hormone Research Foundation Inc. v. Genentech Inc.,* 904 F.2d 1558, 15 USPQ2d 1039 (Fed. Cir. 1990). Accordingly, when there is more than one definition for a term, it is incumbent upon applicant to make clear which definition is being relied upon to claim the invention. Until the meaning of a term or phrase used in a claim is clear, a rejection under 35 U.S.C. 112, second paragraph is appropriate. In applying the prior art, the claims should be construed to encompass all definitions that are consistent with applicant's use of the term. See *Tex. Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1818 (Fed. Cir. 2002). It is appropriate to compare the meaning of terms given in technical dictionaries in order to ascertain the accepted meaning of a term in the art. *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

The word "kneading" is being used in the same context as its ordinary meaning and is meant in terms of mixing the thermoplastic resin and the soft magnetic material powder (such as a dough would be kneaded).

While claims are always open to interpretation in light of the disclosure, it is submitted that a reasonable interpretation of the claims raises no question that recited subject matter is set forth with the required degree of particularity.

The criticism of the claims is urged to be directed to breadth of scope and not indefiniteness. As such, the rejection improperly attempts to limit the scope of the claims by requiring additional limitations under the guise that such limitations are necessary to make the claims definite.

It is submitted that when the claim language is read in light of the specification, an artisan would readily understand the metes and bounds of the invention are. It should be noted also that the disclosure need not recite the claim language in ***haec verba***. ***In re Smith***, 481 F2.d 910, 178 USPQ 620 (CCPA 1973).

In view of the above, withdrawal of this rejection is respectfully solicited.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 102 AND § 103

I. Claim 11 has been rejected under 35 U.S.C. § 102(b) as being anticipated by Kayama et al. (JP2001-237591).

To expedite prosecution, independent claim 11 has been amended to recite, *inter alia*:

> kneading a thermoplastic resin consisting of at least one of polypropylene and methylpentene polymer blended with 30-58% by volume of soft magnetic material powder having a scale-like shape and an aspect ratio of 3-20 and a mean particle diameter converted to spherical diameter of 5-50 μm and with 1-9% by volume of a molding assistant and a kneading assistant to provide a kneaded material;
>
> ...
>
> cooling said injection-molded compact without performing degreasing and sintering for solidification.

Kayama et al. (JP2001-237591) does not disclose the step of kneading the specific thermoplastic resin blended with 30-58% by volume of the specific soft magnetic material powder and 1-9% by volume of a molding assistant and a kneading assistant to provide a kneaded material and the step of cooling the injection-molded compact without performing degreasing and sintering.

Thus, amended independent claim 11 is patentable over Kayama et al. (JP2001-237591) and its allowance is respectfully solicited.

II. Claims 1, 5, 6 and 8 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Wesch (USPN 3,315,259) in view of MatWeb reference and Cotell et al. "Low Dielectric Constant Polymers".

To expedite prosecution, claims 5, 6 and 8 have been canceled, and independent claim 1 has been amended to recite, *inter alia*:

> A composite body for absorbing an electromagnetic wave including a thermoplastic resin consisting of at least one of polypropylene and methylpentene polymer blended with 30-58% by volume of soft magnetic material powder having a scale-like shape and an aspect ratio of 3-20 and a mean particle diameter converted to spherical diameter of 5-50 μm, comprising a unit cell having a bore extending from a top face to a bottom face, wherein
>
> a portion of said bore located on a side of said bottom face has a smaller cross-sectional area than that of said bore at said top face, ...

Neither Wesch, MatWeb, nor Cotell et al. disclose the concept of obtaining the high composite body for absorbing an electromagnetic wave by mixing the specific thermoplastic resin and the specific soft magnetic material powder, as now recited in independent claim 1.

Therefore, amended independent claim 1 is patentable over Wesch in view of MatWeb and Cotell et al., considered alone or in combination, and its allowance is respectfully solicited.

CONCLUSION

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Edward J. Wise (Reg. No. 34,523) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Date: February 6, 2007

Respectfully submitted,

By _____ #39,491
for Charles Gorenstein
Registration No.: 29,271
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747

Attorney for Applicant

Attachment: Copy of Google Search result for definition of word "knead"

Web

Definitions of **Knead** on the Web:

- To work dough with the hands, folding over, pressing down and turning repeatedly.
  www.recipegoldmine.com/glossary/glossaryK.html

- To work dough, usually with the hands, until it is a smooth, pliable mass.
  www.cyberpathway.com/whispers/food/cookterm.htm

- to work a dough by hand or in a mixer to distribute ingredients and develop gluten.
  www.cooksrecipes.com/cooking-dictionary/K-search-results.html

- To make a dough or dough-like substance smooth and elastic by folding, stretching, and pressing it continuously until it reaches the desired texture. (When fondant for candies is kneaded, it gets satiny instead of elastic.)
  www.kissthecooktx.com/1416516_13735.htm

- Mix or work a dough until it stays together and is smooth and elastic. To knead, dust flour where you are working and on your hands. Add more if needed, while you work. Make a ball out of the dough and press down once on it with the heels of your hands. Turn the dough about a quarter of the way around and fold it in half towards you. Press again with the heels of your hands. Keep turning, folding and pressing (about 10 minutes) until the dough does not stick.
  www.ciakids.com/forkids/dictionary/p_dictionary.html

- work a dough lightly by hand to give a smooth texture
  www.livingonadime.com/terms.htm

- To mix a dough in order to make it pliable. Kneading by hand involves pressing, folding and turning the dough with the heels of both hands until it is smooth and elastic.
  wgby.org/localprograms/onthemenu/pages/recipes/glossary.html

- constant folding and pressing of dough, either by hand or by a food mixer with dough hook , until it is completely smooth, the object being to exclude air
  www.great-cooking-made-easy.com/glossary-D-K.html

- to work a food mixture, usually dough, with a pressing, folding motion to a well blended and smooth texture.
  www.texmex.net/Recipes/terms.htm

- to work a food....usually dough...by hand using a back and forth motion.
  www.buttermilkpress.com/glossaryitow.html

- The action used to manipulate bread dough that forms the gluten network in dough. To knead dough flatten into a disk shape, fold it toward you, using the heels of your hands, push dough away with a rolling motion, turn dough on quarter turn and vigorously repeat the fold, push, turn steps.

www.onecook.com/reference/brdgloss.htm

- make uniform; "knead dough"; "work the clay until it is soft"
- massage: manually manipulate (someone's body), usually for medicinal or relaxation purposes; "She rubbed down her child with a sponge"
  wordnet.princeton.edu/perl/webwn

Find definitions of **Knead** in: **English** Russian all languages

---

define:Knead Search

Language Tools | Search Tips | Dissatisfied? Help us improve

Google Home - Advertising Programs - Business Solutions - About Google